

REMARKS

Upon entry of the present amendment, claims 1-29 will remain pending in the above-identified application with claims 1, 2, 6-12, 14, 16, 18-20 and 26-29 standing ready for further action on the merits, claims 3-5 remaining withdrawn from consideration due to an earlier Restriction Requirement of the Examiner, and further claims 13, 15, 17, 21-25 have been withdrawn from consideration due to election of species.

Claims 1-29 have been amended from the viewpoint of formality. The instant amendment made herein to the claims does not incorporate new matter into the application as originally filed. Further, this is a clarifying and not a narrowing amendment. Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

Accordingly, proper consideration of each of the pending claims (i.e., claims 1, 2, 6-12, 14, 16, 18-20 and 26-29) is respectfully requested at present, as is entry of the present amendment.

Restriction/Election

At page 2 of the Office Action, the Examiner indicates that claims 13, 15, 17, 21-25 have been withdrawn from consideration due to an earlier Election of Species Requirement.

However, based on the instant amendment and the arguments set forth below, all rejections in the Office Action have been overcome.

Accordingly, Applicants respectfully request that the Examiner rejoin claims 13, 15, 17, and 21-25, and consider all elected claims 1-4 and 6-29, which belong to Group I, on the merit.

Claim Rejection under 35 USC § 112, 2nd Paragraph

At paragraphs 1-3 at page 2 of the Office Action, claims 1, 2, 6-12, 14, 16, 18-20 and 26-29 have been rejected under 35 USC § 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the Examiner states that it is not clear whether both of the lanthanoid and Group 3B elements are optional or whether the term “optional” is intended only to modify the term “lanthanoid element.”

As described in the instant specification at page 17, line 35 to page 18, line 2, both a yttrium and a Group 3B element are necessary elements, and only a lanthanoid is an optional element in the complex oxide, regarding claim 16.

Thus, in the instant amendment, claim 16 has been amended so as to clarify “a coating layer on the intermediate coating layer comprising a complex oxide of yttrium and a Group 3B element, or a complex oxide of yttrium, a lanthanoid and a Group 3B element.” Similarly, claims 14 and 18 have been also amended.

Accordingly, upon entry of the instant amendment, the rejection under 35 USC § 112, 2nd paragraph has been rendered moot. Applicants respectfully request this rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103(a)

At pages 2-3 of the Office Action (*see paragraphs “4.” and “5.”*), claims 1, 2, 6-12, 14, 16, 18-20 and 26-29 have been rejected under 35 USC § 103(a) as being unpatentable over Takai US '338 (US 2003/0017338).

Takai US '338 can be a reference under 35 USC § 102 (a) or (e) but cannot be a reference under 35 USC § 102 (b), since Takai US '338 is published (on January 23, 2003) before but less than one year prior to the filing date of the present application (i.e., November 19, 2003). Thus, this rejection is based on 35 USC § 102(a)/103(a) or 35 USC § 102(e)/103(a).

Rejections of Claims 1-2 and 6-12

Reference under 35 USC § 102 (a)/§ 103 (a)

Takai US '338 was filed on June 18, 2002 and published on January 23, 2003.

On the other hand, the present application was filed on November 19, 2003, claiming priority from following three Japanese applications:

Japanese Application 2002-336769 filed on November 20, 2002
(1st JP priority Application);
Japanese Application 2002-356171 filed on December 9, 2002
(2nd JP priority Application); and
Japanese Application 2003-089797 filed on March 28, 2003
(3rd JP priority Application).

The 1st and 2nd JP priority Applications have earlier filing date than the publication date of Takai US '338.

Further, claims 1-2 and 6-12 of the present invention are fully supported by the 1st and 2nd Japanese priority applications, verified English translations of which are submitted herewith, respectively.

Therefore, Applicants have perfected their claim to priority under 35 U.S.C. § 119 and have appropriately antedated the Takai US '338 reference. Therefore, the rejection of claims 1-2 and 6-12 under 35 USC § 102 (a)/§ 103(a) over Takai US '338 has been rendered moot.

Accordingly, withdraw of these rejections is respectfully requested.

Reference under 35 USC § 102 (e) /§ 103 (a)

Takai US '338 is published (on January 23, 2003) before but less than one year prior to the filing date of the present application (i.e., November 19, 2003).

Thus, this rejection seems to be based on 35 USC § 102(e)/103(a).

However, 35 USC § 103 (c) (1) sets forth, as follows:

(c) (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

A Statement under 37 CFR § 1.130 has been filed herewith. As noted in the Statement, the claimed invention and Takai US '338 were, at the time the claimed invention was made, subject to an obligation of assignment to the same person (i.e., Shin-Etsu Chemical Co. Ltd.). Thus, the common ownership under 35 USC § 103(c) (1) was established at the time the claimed invention was made.

Thus, upon entry of the Statement under 37 CFR § 1.130 submitted herewith, the Takai US '338 reference has been properly disqualified.

Accordingly, Applicants respectfully submit the rejection under 35 USC § 103(a) has been rendered moot and request that the Examiner withdraw this rejection.

Rejections of Claims 14, 16, 18-20 and 26-29

With regard to claim 14, 16 and 18-20, a heat resistant coated member of the present invention comprises a substrate, a specific intermediate coating layer, and a specific coating layer of a specific complex oxide.

With regard to claim 26-29, a heat resistant coated member of the present invention comprises a substrate and a specific coating layer of a specific complex oxide.

However, Takai US '338 fails to disclose or suggest both the specific coating intermediate layer and the coating layer of a complex oxide.

Thus, A *prima facie* case of obviousness is not established based on the cited reference. Likewise, it follows that a person having ordinary skill in the art would not be motivated by any of the teachings of the cited references to arrive at the present invention.

Accordingly, the present invention (claim 14, 16, 18-20 and 26-29) is not obvious over the cited reference.

CONCLUSION

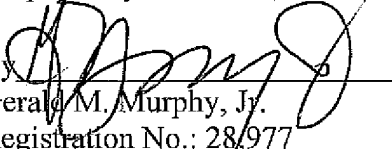
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims are allowed under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy, Jr. (Reg. No. 28,977) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 
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